REMARKS

Claims 22-26 and 28-30 are pending and stand rejected by the Examiner. Claims 22-26 and 28-30 have not been amended and are presented for examination. Applicants gratefully acknowledge the Examiner's withdrawal of the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, as well as the withdrawal of the objection to the oath. Applicants respond below to the specific rejections raised by the Examiner in the final Office Action mailed August 18, 2006. For the reasons set forth below, Applicants respectfully traverse.

Rejection Under 35 U.S.C. § 102(a)

The Examiner has maintained the rejection of Claims 22-25 and 28-29 as allegedly being anticipated under 35 U.S.C. § 102(a) by WO 99/58660 to Ruben et al. ("Ruben I"), published November 18, 1999. According to the Examiner, Ruben I teaches an amino acid sequence (SEQ ID NO: 131) that is 99.6% identical to SEQ ID NO: 57 of the instant application, and discloses epitopes along the entire length of the protein which can be used for the production of antibodies. Therefore, the Examiner argues that Ruben discloses each and every element of the rejected claims. The Examiner argues that the Declaration Under 37 C.F.R. § 1.131 submitted with Applicants' *Amendment and Response* filed June 20, 2005, in conjunction with the disclosure in Applicants' claimed priority application U.S.S.N. 60/130,359, is insufficient to antedate Ruben I. According to the Examiner, the Declaration establishes that Applicants were in possession of the polypeptide of SEQ ID NO:57 prior to Ruben I, but not of the antibodies to the polypeptide of SEQ ID NO:57. Regarding U.S.S.N. 60/130,359, the Examiner argues that in order for Applicants' provisional application to constitute a constructive reduction to practice, it must conform to 35 U.S.C. § 112, first paragraph, and teach the skilled artisan how to make and use the claimed invention. According to the Examiner, U.S.S.N. 60/130,359 fails to meet this requirement since the results of the mesangial cell proliferation assay, which the Examiner agrees demonstrates how to use the polypeptides of SEQ ID NO:57, are not disclosed in the application. The Examiner also argues that U.S.S.N. 60/130,359 fails to adequately describe labeled antibodies or fragments of antibodies that are the subject of Claims 25, 26, 28 and 29 of the instant application. Finally, the Examiner argues that the Declaration does not provide evidence

of diligence during the time period between when the mesangial cell proliferation experiments were performed and when the provisional application was filed.

As correctly stated by the Examiner, "[t]he rejection [under 35 U.S.C. §102(a)] could be overcome by providing evidence that applicant was in possession of the invention before the effective date of the reference." The only element that the Examiner alleges is lacking in the disclosure of U.S.S.N. 60/130,359 to demonstrate a constructive reduction to practice is the results of the mesangial cell proliferation assay, which the Examiner has agreed establishes a utility for the claimed antibodies under 35 U.S.C. §112, first paragraph: "the examiner does not question whether the best mode and written description criteria are met for the case of monoclonal antibodies, nor is there any doubt that the provisional application teaches how to make the monoclonal antibodies," *Id.*

The first Declaration Under 35 U.S.C. § 1.131 by Goddard et al., referred to in Applicants' *Response to Office Action* filed April 26, 2006, establishes that Applicants had reduced the polypeptides of SEQ ID NO: 57 to practice prior to the effective date of Ruben I. The Examiner states that "the examiner is convinced applicant actually reduced to practice the protein of SEQ ID NO: 57 before the date of the reference by Ruben was published." *Id.* at 4. In other words, the Examiner has agreed that Applicants' provisional application establishes that Applicants had established everything necessary to demonstrate possession of the invention prior to Ruben I, save the results of the mesangial cell proliferation assay, which the Examiner agrees Applicants' had possessed prior to Ruben I as evidenced by the 1.131 Declaration: "As stated previously, the examiner is convinced applicant actually reduced to practice the protein of SEQ ID NO:57 before the date the reference by Ruben [I] was published." *Office Action* at 4. Since the Examiner agrees that the 1.131 Declaration and U.S.S.N. 60/130,359 contain the necessary information to establish possession of the invention prior to Ruben I, Applicants respectfully request that the rejection under 35 U.S.C. §102(a) be withdrawn. Further, as the disclosure in U.S.S.N. 60/130,359 and the mesangial cell proliferation assay were both completed prior to Ruben I, there is no need to provide evidence of diligence during the time period between when the mesangial cell proliferation experiments were performed and when the provisional application was filed.

The Examiner also states that "the declaration must teach at least as much as the reference." *Final Office Action* at 5. Applicants submit, and the Examiner agrees, that the Declaration submitted on June 20, 2005 establishes that Applicants were in possession of the polypeptides of SEQ ID NO: 57. Without agreeing with the Examiner's assertions regarding the adequacy of the disclosure in U.S.S.N. 60/130,359, Applicants maintain that the Declaration unambiguously fills the alleged gap in Applicants' disclosure in U.S.S.N. 60/130,359, to demonstrate that Applicants had at least constructively reduced the claimed invention to practice.

Regarding the Examiner's assertions that U.S.S.N. 60/130,359 does not "provide adequate written support . . . for labeled antibodies . . .or to the specific fragments of the antibodies" claimed in Claims 25-26 and 28-29, Applicants refer the Examiner to page 49 of the specification, which includes an extensive discussion regarding the labeling of antibodies. U.S.S.N. 60/130,359 also describes the claimed antibody fragments. Page 44 of the specification states that "[d]igestion of antibodies to produce fragments thereof, particularly, Fab fragments, can be accomplished using routine techniques known in the art" and that "[h]umanized forms of non-human (e.g., murine) antibodies are chimeric immunoglobulins, immunoglobulin chains or fragments thereof (such as Fv, Fab, Fab', $F(ab')_2$ or other antigen-binding subsequences of antibodies) which contain minimal sequence derived from non-human immunoglobulin." *U.S.S.N. 60/130,359* at p. 44. As such, the specification contains adequate written description of the full scope of the invention claimed in Claims 25-26 and 28-29.

In view of the foregoing, Applicants maintain that they were in possession of the invention of Claims 22-25 and 28-29, and had constructively reduced the claimed invention to practice prior to the effective filing date of Ruben I. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102(a).

Rejection Under 35 U.S.C. § 102(e)

The Examiner has also maintained the rejection of Claims 22-25 and 28-29 as allegedly being anticipated under 35 U.S.C. § 102(e) by U.S. Patent Application Publication No. 2003/0100051 to Ruben et al. ("Ruben II"), with an effective filing date of November 10, 1999. For the same reasons that the Examiner found that Applicants had not overcome the rejection over Ruben I, above, the Examiner maintains that Applicants' Second Declaration under 37

C.F.R. §1.131, a copy of which is provided herewith, is insufficient to antedate Ruben II and overcome the rejection under 35 U.S.C. § 102(e).

The Second Declaration Under 37 C.F.R. § 1.131 of Audrey Goddard, Paul Godowski, Austin Gurney, James Pan, Colin Watanabe, and William Wood, submitted in related U.S. Patent Application No. 10/036,342 ("the Second 1.131 Declaration"), relates to the same set of facts, but demonstrates that the mesangial cell proliferation assay was completed prior to November 10, 1999. Under the same reasoning set forth in the discussion of the rejection under 35 U.S.C. § 102(a), the Second 1.131 Declaration demonstrates that Applicants were in possession of the claimed invention prior to the publication date of Ruben II. Therefore, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102(e).

Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 22-26 and 28-30 as allegedly being unpatentably obvious over Ruben II in view of Holmes (1995), *Current Protocols Mol. Biol.* pp. 5.35-5.3.8 ("Holmes"). As discussed in the discussion regarding the rejection under 35 U.S.C. § 102(e), the Examiner maintains that Ruben II teaches antibodies and antibody fragments that bind to SEQ ID NO:57. The Examiner also maintains that Holmes teaches conjugation of multiple labels to antibodies for the purpose of detection. According to the Examiner, it would have been obvious to one skilled in the art to label the antibodies or antibody fragments of Ruben II for the purposes of detecting PRO4380.

As discussed above, the Second 1.131 Declaration and US 60/130,359 establish that Ruben II is not prior art under 35 U.S.C. § 102(e), and as such cannot be relied upon to support a rejection under 35 U.S.C. § 103(a). Applicants submit that the rejection under 35 U.S.C. § 103(a) is improper.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a).

CONCLUSION

The present application is believed to be in condition for allowance, and an early action to that effect is respectfully solicited. Applicants invite the Examiner to call the undersigned if any issues may be resolved through a telephonic conversation.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Oct. 17, 2006

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